REMARKS

Claims 1-22 are pending in the present application. By this amendment, Claims 1-5, 7-14 and 21 have been amended. Applicants respectfully request consideration of the present application in view of the foregoing amendments and the following remarks. No new matter has been added.

I. FORMAL MATTERS

Examiner Interview

Inventor, Dean Joseph Harbaugh and attorney J. Rodman Steele, Jr. thank examiners John G. Wise and Traci L. Smith for the interview courteously granted on October 7, 2004. During the course of the interview, the examiners read certain references such as Grad College on the claims as some of the language in applicant's claims and specification could be interpreted to be covered by the citations.

During the course of the interview on October 7, 2004, Inventor Harbaugh and Attorney Steele presented oral evidence directed to secondary considerations including long felt but unresolved need and commercial success. Applicant attaches herewith various affidavits that support the oral comments of Dean Harbaugh and Attorney Steele. As emphasized during the interview, various professional organizations, such as the ABA, have long recognized that there are deficiencies in the law school selection process which process depends heavily on a student's undergraduate GPA and their LSAT score. It has been widely recognized that not withstanding relatively poor GPA and LSAT scores certain lower quartile candidates nevertheless can do well in law school and become successful attorneys. This situation which has been born out at the applicant law school, is compounded in that as can be appreciated from the enclosed Iowa Law Review Article, 83 Iowa Law Review 139 (Oct. 1997), students of color and from disadvantaged backgrounds typically have lower LSAT scores than their classmates. Thus the diversity problem and the inability to select candidates from minority groups has been a great concern to legal educators and bar association leaders. The Iowa Law Review Article is also very helpful in emphasizing that the law school situation is somewhat unique to education as there are considerations in reading and understanding judicial opinions that separate law from other graduate criteria. Such discussion is particularly pertinent to applicants Claim 10-12 which are directed specifically to law school admission.

Further, the affidavits of Richard A. Matasar, Dean of New York Law School, and Thomas F. Guernsey, President and Dean of Albany Law School of Union University, demonstrate that the diversity challenges are extremely important and that the standard GPA/LSAT admission criteria has fallen short and in fact has been a problem for many years. Thus applicant's invention seeks to answer a long felt but unresolved need that qualifies a subject application for consideration under this particular secondary consideration, and falls within the secondary objective considerations of the well-established factual inquiries set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966) that are used to determiner whether an invention is non-obvious.

Further the affidavit of Dean Joseph Harbaugh sets forth the success that not only has been enjoyed by Nova Law School with the program covered by the subject application but also describes how the subject program has achieved success through licensing to other law schools to enable the program to be more widely used to achieve more appropriate balances within admissions to help correct diversity imbalances.

It must be recognized that the licensing of a program such as that covered in the subject application is extremely rare within the law school culture.

Objections to the Abstract

The Abstract was objected to as allegedly being greater than 150 words in length. This objection is respectfully traversed. The Abstract is approximately 120 words. As such, the Abstract is less than 150 words and Applicant respectfully submits that it does not need to be amended at this time. As such, Applicant respectfully requests withdrawal of this objection.

Claim Rejections Under 35 U.S.C. §112, first paragraph

Claims 3, 12 and 15 were rejected under 35 U.S.C. §112, first paragraph as allegedly failing to provide an adequate description of the process of calibrating grades. This rejection is respectfully traversed.

As set forth on page 16, lines 1-25 and Figure 5 of the application, a calibrated grading process is described in sufficient manner as to enable one of ordinary skill in the art to use the present invention. The term "calibrated" has a well known definition of breaking into different groups. As such, calibrated grading separates grades from an individual (for multiple tests) or

multiple individuals (for a single test) into different levels. And while a thorough internet search may not have uncovered a definition describing how the process works, Applicant is unaware of any requirement that a process must be described on the internet for one of ordinary skill in the art to understand the process. Applicant submits herewith several websites (Exhibit A), all found on the internet, in which calibrated grading is described as being used. As these sites reference the process, but do not provide a description, Applicant submits that those of ordinary skill in the art do know how to perform calibrated grading. Accordingly, Applicant respectfully submits that the term is adequately described in accordance with accepted U.S. patent law based upon knowledge of those skilled in the art and Applicant's description in regards to how the process is used in Applicant's claimed invention. As such, Applicant respectfully requests withdrawal of this rejection.

Claim Rejections Under 35 U.S.C. §101

Claims 1-21 were rejected under 35 U.S.C. §101 as allegedly lacking utility. This rejection is respectfully traversed.

Applicant is unaware of the Examiner's interpretation of 35 U.S.C. §101. There is no discussion of "physical science as opposed to social sciences" or "must somehow apply, involve, use or advance the technological arts." As set forth in 35 U.S.C. §101 and MPEP §2107.01, utility is satisfied when Applicant claims an invention that is within statutory subject matter and that the invention is "useful." Applicant's invention is not directed to printed matter, a naturally occurring article, a scientific principal, or atomic energy. The Examiner has not cited inoperativeness, perpetual motion, frivolous, fraudulent, or against public policy as a basis for utility. As such, Applicant respectfully submits that the Examiner has failed to provide a proper basis for this rejection.

As Applicant's claimed invention is directed to a process, and as a process is within the technological arts, Applicant's claimed invention satisfies the first prong of the test. As Applicant's claimed invention identifies and admits potential students that are capable of handling a particular curriculum, and as these potential students had previously been rejected using "standard" admissions criteria, Applicant's claimed invention is useful as it identifies and admits students to a school that will succeed, thereby increasing the graduation rate of the school. An additional utility lies in the possible enhancement of diversity as certain groups do

not test well on standardized tests, thereby causing a person to be rejected under "standard" admissions criteria. However, Applicant's claimed process identifies some of these rejected candidates and admits them based upon their demonstrated ability to handle that school. Accordingly, these two aspects are "useful" to any school in attempting to locate and admit students that will do well in that school, even if "standard" admissions criteria reject these candidates.

Based upon the Examiner's test, Applicant's have invented a new "process", which is within the technological arts. The invention provides a useful, concrete and tangible result of identifying and admitting students to a school, those students who would otherwise have been rejected under "standard" admissions criteria even though they would have been able to handle that school's curriculum. This is not an abstract idea, but rather applies, involves and uses a technological art, i.e. a process. Specifically, in regards to claims 1-4, 6-7, 10-16, 18 and 20-21, these claims do involve the incorporation of a technological art as they involve a process. As such, these claims are not an abstract idea. In regards to claims 5, 8-9, 17 and 19, the Examiner has acknowledged that they involve a technological art and Applicant is unaware of a requirement that an "advancement" of the technological art be needed for utility to be satisfied, although Applicant submits that the present invention does advance the science of admitting students to a school by admitting students who would otherwise have been rejected under "standard" admissions criteria even though they would have been able to handle that school's curriculum.

For at least the reasons given above, Applicant respectfully submits that Applicant's claimed invention satisfies the statutory requirements of utility as set forth in 35 U.S.C. §101 and respectfully request withdrawal of this rejection.

II. PRIOR ART REJECTIONS

Claim Rejections Under 35 U.S.C. §102 (b)

Claims 1, 13 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by www.gradcollege.swt.edu (hereafter "Grad College"). This rejection is respectfully traversed.

Grad College is directed to a well known practice of conditionally admitting students to a university. As set forth, when a student is conditionally admitted, they must maintain some certain requirements, such as a selected grade point average, to stay in the school.

Applicant's claimed invention, however, is not directed to conditionally admitting students. Rather, Applicant's claimed invention is an admissions tool which is directed to identifying and admitting, unconditionally, certain students that have either been previously rejected for admission or who most certainly be so rejected because of their application deficiencies including poor LSAT scores. This is accomplished by testing students as part of an admissions process that includes an abbreviated academic program. However, as specifically claimed, the test takers do not have acceptable qualifications and "have not received an offer of admission to any one of said academic institutions."

Applicant's claimed admission process is outside the curriculum offered by the school as the test takers have not been admitted to the school. Thus, Applicant's program must be viewed as part of the admission's process and its value is totally restricted to an admission tool and not otherwise a part of the academic program. This admission program may be taken in a classroom or on-line, and may be taken by an out-of-state applicant, thereby permitting an out-of-state applicant to prove their ability and get an unconditional admittance to a school without moving to the school and beginning the school's actual curriculum under a conditional admittance, as taught by Grad College.

In addition, as stated during the interview, since Grad College and other references are directed to conditional admission of students under certain criteria, the choice of similar language in applicant's specification and claims has led to confusion. In Grad College and other references and in fact other programs which are known throughout the country, certain criteria are set forth that enable a border line student to be admitted in a graduate school provisionally based upon a calculated appraisal that if such student works diligently he maybe able to succeed. Specifically these programs involve the student in regular institution programs which result in credit towards a degree being allowed. If the student successfully completes the courses with an appropriate grade then the conditional admission changes to a full admission and that student is part of the regular student body. It is noteworthy that these courses are in fact regular credit courses which the students that are conditionally admitted take along with regularly admitted students.

These types of programs are considerably different from applicant's program not withstanding the use of conditional admitting type of language in applicant's specification and original claims. As applicant is using "conditional admissions", it is speaking of a narrow

limited program that is not part of the regular academic program but rather a part of the admissions program of the school. It is very important to distinguish this program from the regular academic program and accordingly emphasis is placed on the fact that this program is part of the admissions program. If the students meet the necessary criteria to be considered for admission, they are given an abbreviated academic program that has been specially designed according to expertise which has been developed by applicant. If in fact a candidate does well in this program under applicant's criteria, even though such candidate may not have done well in tests like the LSAT's, nevertheless this candidate shows an ability to proceed at the graduate level. Thus, while in a sense this is a conditional admission, it is not a conditional admission to the school itself but merely to the limited admissions program. That this is in fact a limited program within the admissions office is supported by specification language on page 11, 12, 13 and 14 of the specification. In other words, the "conditional" admission is just that, i.e. conditional upon the student satisfying the admission criteria i.e. successfully passing the abbreviated academic program which again it is stressed is only for admission purposes and does not enable the student to attend classes with others or to achieve academic credit.

Claim 1 has been amended by providing "an admissions program that includes an abbreviated academic program". Further the language of "conditionally admitted" test takers has been eliminated so that there will be no confusion with the programs such as the program of Grad College sited against Claim 1. Additional consistent amendments have been made through the claims as for example in Claim 13 where the amendments make it clear that identified candidates have the opportunity "to enter the admissions process and as part thereof, engage in an abbreviated academic program". Thus, it is important to recognize that this is an abbreviated program and while academic in nature, it is nevertheless only part of the admissions process i.e. it is for the sole purpose of determining whether the student is to be admitted and does not provide any academic credit when completed.

Applicant is not aware of any prior art that provides teaching and subsequent testing within the admissions process to better evaluate the prospect of a candidate.

For at least the reasons given above, Applicant respectfully submits that Claims 1 and 13 are allowable over the prior art of record. Furthermore, as Claim 20 recites additional claim features and depends from Claim 13, this claim is also allowable over the prior art of record.

Claim Rejections Under 35 U.S.C. §103 (a)

Claims 2, 4, 7, 14 and 18-19 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over Grad College in view of New York Times article to Arenson (hereafter "Arenson"). This rejection is respectfully traversed.

As with Grad College, Arenson is not directed to identifying and admitting students who have previously been rejected to a school. Arenson is directed to a program for students already enrolled in a school to advance to a particular senior college within that school. Additionally, Arenson fails to teach or suggest the use of on-line instruction and testing to permit an out-of-state student to be admitted without having to move to and attend the school in question. As such, it is respectfully submitted that the combination of Grad College and Arenson fails to teach or suggest Applicant's claimed invention.

For at least the reasons given above, Applicants respectfully submit that Claims 1 and 13 are allowable over the prior art of record. Furthermore, as Claims 2, 4, 7, 14 and 18-19 recite additional claim features and depend from Claim 1 or Claim 13, these claims are also allowable over the prior art of record.

Claims 5-6, 8-9, 16-17 and 21 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over Grad College in view of Arenson and further in view of U.S. Patent No. 6,146,148 to Stuppy (hereafter "Stuppy"). This rejection is respectfully traversed.

As with Grad College and Arenson, Stuppy is not directed to identifying and admitting students who have previously been rejected to a school. Stuppy simply teaches a method of automated delivery of instructional material. The invention described in Stuppy automates the testing process. However, Stuppy is directed to teaching students who have already been admitted to a school, not to identifying and admitting students who have previously been rejected to a school. As such, it is respectfully submitted that the combination of Grad College, Arenson and Stuppy fails to teach or suggest Applicant's claimed invention.

For at least the reasons given above, Applicants respectfully submit that Claims 1, 13 and 21 are allowable over the prior art of record. Furthermore, as Claims 5-6, 8-9 and 16-17 recite additional claim features and depend from Claim 1 or Claim 13, these claims are also allowable over the prior art of record.

Claims 10-11 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over Grad College in view of Arenson and further in view of LSAC publication article (hereafter "LSAC"). This rejection is respectfully traversed.

As with Grad College and Arenson, LSAC is not directed to identifying and admitting students who have previously been rejected to a school. LSAC is directed to the use of LSAT scores in deciding admittance to law school. This is different than conditional admittance taught by Grad College and does not teach or suggest admitting someone to law school who has previously been rejected to that law school. As such, it is respectfully submitted that the combination of Grad College, Arenson and LSAC fails to teach or suggest Applicant's claimed invention.

For at least the reasons given above, Applicants respectfully submit that Claim 1 is allowable over the prior art of record. Furthermore, as Claims 10-11 recite additional claim features and depend from Claim 1, these claims are also allowable over the prior art of record.

Claim 22 stands rejected under 35 U.S.C. §103 (a) as being unpatentable over Grad College in view of U.S. Patent No. 6,088,686 to Walker et al. (hereafter "Walker"). This rejection is respectfully traversed.

As with Grad College, Walker is not directed to identifying and admitting students who have previously been rejected to a school. Walker is simply directed to an on-line admissions process. Accordingly, Walker does not teach or suggest any on-line academic program for admitting students or any other aspect of Applicant's claimed invention other than the fact that both may be machine readable storage. As such, it is respectfully submitted that the combination of Grad College and Walker fails to teach or suggest Applicant's claimed invention.

For at least the reasons given above, Applicants respectfully submit that Claim 22 is allowable over the prior art of record.

III. CONCLUSION

For at least the reasons given above, Applicant submits that Claims 1-22 define patentable subject matter. Accordingly, Applicant respectfully requests allowance of these claims.

The foregoing is submitted as a full and complete Response to the Office Action mailed August 19, 2004, and early and favorable consideration of the claims is requested.

Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is respectfully requested to contact Applicant's representative at the telephone number listed below.

Applicants provides herewith a fee in the amount of $xxx to cover the cost of a three-month extension of time. No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 50-0951.

Respectfully submitted,

Date: February 22, 2005

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